

### REMARKS

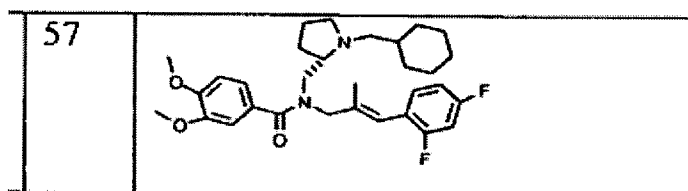
This Amendment and Request for Reconsideration ("Amendment") is in response to the September 6, 2007 Office Action ("Office Action"). Applicants hereby cancel claims 10-13, and amend claim 1. Support for the amendments to claim 1 can be found at least at paragraph [0058] of the specification as filed. In addition, claim 27 is amended to correct a typographical error. Applicants respectfully request that the amendments be entered.

#### Response to Restriction Requirement

Claims 1-38 are pending. Claims 1, 3, 5, 6, 10, 12, 13, 19-22, 24-27 and 29-33 and 38 were examined in the Office Action dated September 6, 2007.

Applicants would like to thank the Examiner for setting forth groups with the restriction requirement in this Office Action. However, Applicants are still somewhat unclear regarding the two successive restriction requirements that have been received. Attempts to clarify the present Office Action over the phone during a phone conversation on December 14 were unsuccessful.

To the extent this latest restriction requirement is understood, Applicants elect Group I with traverse. Applicants identify claims 1-8, 14-22, 24-30, 33, 36, and 38 which are readable thereon. Applicants again elect compound 57 represented by the following structure:



Applicants identify claims 1, 3, 5, 6, 10, 19-22, 24-27, 29-33, 36, and 38 which are readable thereon.

Applicants respectfully submit that claim 1 is generic, and should claim 1 be found to be allowable, all of the non-elected claims should be rejoined to the present application. In addition, Applicants reserve the right to file an unamended version of claim 1 in a continuation application.

Applicants traverse based on the fact that the various groups are readily searchable together if a proper backbone search is used. According to the Office Action, "there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter[.]" Office Action at page 6. Applicants disagree with the restriction requirement and hereby request reconsideration and withdrawal of the requirement.

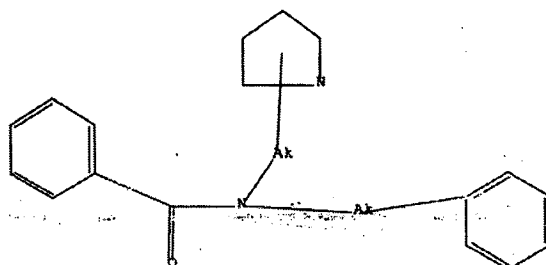
Applicants point out that, as amended, the claims require that Z is a heterocyclic 5- or 6-membered ring with one and only one nitrogen atom in the ring.

In addition, Applicants submit that an undue or serious burden has not been established with respect to the search required. Applicants note that the Examiner's search strategy and results posted to PAIR on 08-17-2007 do not indicate that the backbone of the Applicants' claimed structures was searched in STN, but instead a different, broader structure was searched. Applicants' claims require a backbone of phenyl-C(O)-N-CH<sub>2</sub>-C=C-phenyl. In contrast, the Examiner's search strategy mischaracterized the Applicants' claims and instead searched structures that have a general alkyl group between the amide group and phenyl instead of the backbone including -C(O)-N-CH<sub>2</sub>-C=C-.

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Applicants respectfully submit that the burden required to search the amended claims is not undue, nor is the burden serious. A search whereby Z is limited to 5- and 6- membered rings comprising only one nitrogen atom would be less broad than the search previously performed by the Examiner in this case. The fact that compounds within the genus could be classified in different Classes does not necessarily imply that the search burden would be undue. In this case, there is a clear backbone common to all of the compounds that allows for a search to be performed without undue effort.

Applicants reserve the right to petition under 37 C.F.R. § 1.144. Furthermore, to the extent that Applicants' arguments regarding traverse are not accepted, Applicants respectfully reserve the right to rejoin claims from Group II, such as claims 16, 17 and 18. See MPEP 821.04. Assuming that the Examiner accepts Applicants' arguments regarding traverse and withdraws the restriction requirement, claims 1-9 and 14-30 should be pending.

**Response to Rejection Under 35 U.S.C. § 103**

Claims 1, 3, 5, 6, 10, 12, 13, 19-22, 24-27, 29-33 and 38 stand rejected under 35 U.S.C. § 103 as allegedly obvious over WO 01/98272 to Eriksson ("Eriksson"). According to the Office Action, Eriksson "generically teaches structurally similar compounds, which embraces applicant's claimed invention." Office Action at page 13, first paragraph. For support, the Office

Action cites specifically "page 2, formula (I), compound on page 11-15 the examples, and claims." *Id.* Moreover, the Office Action states, "The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of the above cited references with the expectation of obtaining additional beneficial compounds." *Id.* at paragraph 3.

Applicants submit that the pending claims are not obvious over Eriksson because the Office Action has not established a prima facie case of obviousness in this case. To establish a prima facie case of obviousness, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or prior art to make the claimed compounds. See MPEP § 2142. *Id.* (See also *Takeda Chemical Industries, Ltd., v. Alphapharm* (Fed. Cir 2007)(stating post-KSR that "a prima facie case requires a showing of 'adequate support in the prior art' for the change in structure." (citing *In re Grabiak*, 769 F.2d 729, 731-32 (Fed. Cir 1985)) and stating that the pre-KSR law regarding a prima facie case of obviousness "is consistent with the legal principles enunciated in KSR.") Accordingly, the claims are not obvious and the rejection should be withdrawn.

For a chemical compound, a prima facie case of obviousness requires "structural similarity between claimed and prior art subject matter ... where the prior art gives reason or motivation to make the claimed compositions." *In re Dillon*, 919 F.2d 688, 692, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990)(en banc).

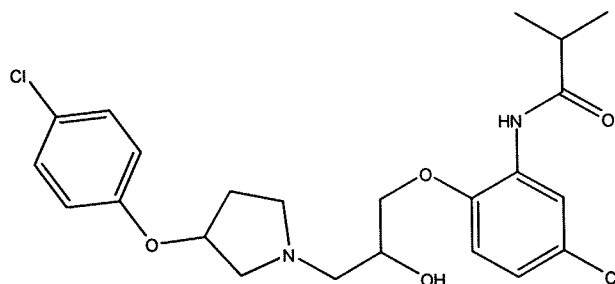
In this case, the only cited art is Eriksson. Although, in some situations, a single prior art reference can render a claim obvious, see, e.g. *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996), there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. *Id.* Even

thought the suggestion or motivation may be derived from the prior art itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, see, *O'Farrell*, 853 F.2d 894, 902, 7 U.S.P.Q.2d 1673, 1680, in this case, no such teaching, suggestion or motivation has been identified.

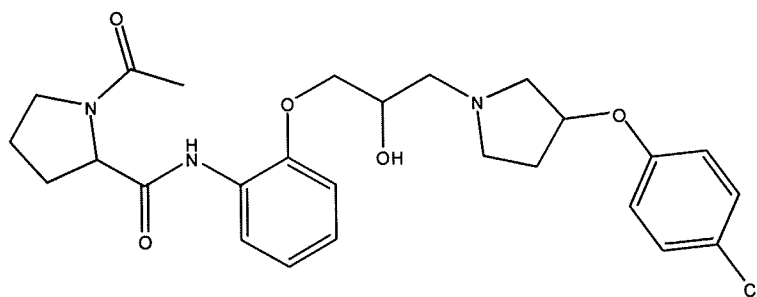
This is not a case of close similarity or even remote similarity, e.g. adjacent homologues, See e.g., *In re Henze*, 181 F.2d 196, 85 U.S.P.Q.2d 261 (C.C.P.A. 1950); tautomers, See, *Ex parte Bluestone*, 135 U.S.P.Q. 199 (POBA 1961)(R<sup>6</sup> is alkyl, hydrogen, or halogen), plural -CH<sub>2</sub>- groups, *Ex parte Fauque*, 121 U.S.P.Q. 425 (POBA 1954), ring enlargement, *Ex parte Thomson*, 119 U.S.P.Q. 254 (POBA 1954), ring contraction, *In re Lunsford*, 357 F.2d 380, 148 U.S.P.Q. 721 (C.C.P.A. 1966), or isomers. This is a case of very different compounds.

Eriksson discloses a variety of compounds. For example,

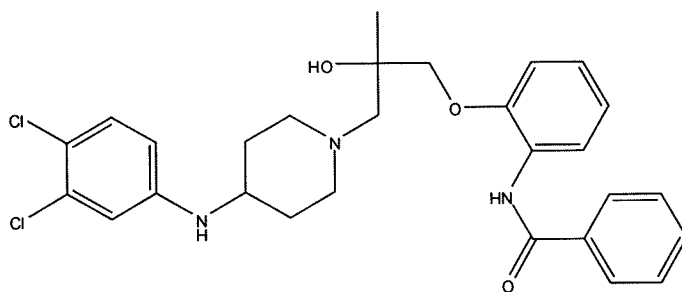
- N (5-Chloro-2- {3- [3- (4-chloro-phenoxy)-pyrrolidin-1-yl]-2-hydroxy-propoxy}- phenyl)-isobutyramide, Example 1, at page 9, line 16-17 and page 21, lines 19-20.



- 1-Acetyl-pyrrolidine-2-carboxylic acid (2- {3- [3- (4-chloro-phenoxy)-pyrrolidin-1-yl]- 2-hydroxy-propoxy}-phenyl)-amide, Example 18 at page 10, line 21-22 and page 27, lines 15-16



- N- (2- {3- [4- (3,4-Dichloro-phenylamino)-piperidin-1-yl]-2-hydroxy-2-methyl-propoxy}-phenyl)-benzamide, Example 99, at page 16, lines 5-6 and page 45, lines 29-30.



None of the Eriksson compounds appear to include two phenyl groups linked by a backbone of five atoms. Although some compounds disclosed in Eriksson have an amide moiety, none have it in the arrangement of phenyl-C(O)-N-CH<sub>2</sub>-C=C-phenyl as required by the claims. Accordingly, the compounds of Eriksson are not structurally similar to the claimed compounds.

Other than stating that “the instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of [Eriksson] with the expectation of obtaining additional beneficial compounds”, the Office Action does not indicate why one would have made the specific, and very significant, changes to the Eriksson compounds to arrive at the claimed compounds.

“[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142. The Office Action has not established that the prior art teach or

suggest making the specific changes to the Eriksson compounds to make the claimed compounds. Accordingly, since a prima facie case has not been established, Applicants respectfully request that the rejection be withdrawn.

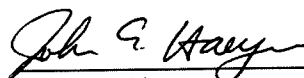
**Obviousness-type Double Patenting**

Claims 1-38 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of co-pending application 11/202,961. Upon allowance of claims in this application, applicants will provide an appropriate terminal disclaimer over co-pending application 11/202,961.

**CONCLUSION**

Applicants believe that claims 1-9, and 14-30 are now in condition for allowance. Applicants reserve the right to pursue unclaimed subject matter in later continuation or divisional applications. Applicants respectfully request that the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned agent for the applicants via telephone if such communication would expedite this application.

Respectfully submitted,



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